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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/855,402	05/13/1997	CHRISTOPHER BRADFELD		1652

32116 7590 09/23/2002

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
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EXAMINER

ULM, JOHN D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 09/23/2002

29

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/855,402

Applicant(s)
Bradfield et al.

Examiner
John Ulm

Art Unit
1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 8, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 28 6) ☐ Other:

Art Unit: 1646

- 1) Claim 21 is pending in the instant application. Claim 21 has been amended and claims 22 to 27 have been canceled as requested by Applicant in Paper Number 26, filed 08 July of 2002.
- 2) Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.
- 3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 4) Claim 21 stands rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention and in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with the claims for those reasons of record as applied to claims 21 to 27 in section 7 of Paper Number 24. As stated therein, because claim 21 recites the limitation "and substitutions thereof" in reference to a sequence, the sequence limitation of this claim has no meaning since it allows one to replace ("substitute") the referenced sequence with an entirely different sequence. Therefore, this claim encompasses any composition that is encompassed by the term "an isolated and purified polypeptide". The instant specification clearly fails to provide a written description of all isolated polypeptides.

Art Unit: 1646

5 & 6) Claim 21 stands rejected under 35 U.S.C. 102(a) as being clearly anticipated by the Ema et al. publication (BIOCHEM. BIOPHYS. RES. COMM. 184(1):246-253, 15 Apr. 1992) and under 35 U.S.C. 102(b) as being clearly anticipated by the Bradfield et al. publication (MOLECULAR PHARMACOLOGY 39(1):13-19, 1991) for those reasons of record. Figure 1c of the Ema et al. publication provided a written description of the complete amino acid sequence of an isolated murine Ah receptor prior to the filing of the instant application. The Bradfield et al. publication clearly described an isolated murine liver Ah receptor more than one year before the filing on the instant application. The amino acid sequence presented in Figure 1c of Ema et al. appears to be identical to SEQ ID NO:2 of the instant application and the evidence of record clearly supports a conclusion that the amino acid sequence of the murine AH receptor described by Bradfield et al. is presented in SEQ ID NO:2 of the instant application. Because the murine Ah receptor of the instant invention and the murine Ah receptor of Bradfield et al. were purified from the same source by employing essentially the same steps, as outlined on page 10 of the instant specification, one would reasonable conclude that they are the same protein. Therefore, any property possessed by the claimed protein, such as its amino acid sequence, would be expected to be an inherent property of the prior art protein. See M.P.E.P. 2112. Further, the amino acid sequence presented in SEQ ID NO:37 of the instant specification and in Figure 1c of Ema et al. is identical to residues 12 to 83 of the murine amino acid sequence presented in SEQ ID NO:2 of the instant application except for a serine to threonine substitution at position 63 of SEQ ID NO:37. This substitution is encompassed by the current claim limitation “and substitutions

Art Unit: 1646

thereof", as conceded by Applicant in the first paragraph on the third page of Paper Number 26. Therefore, the murine Ah receptors of Ema et al. and Bradfield et al. meet all of the limitations of claim 21 either explicitly or inherently.

7) Applicant's arguments filed 08 July of 2002 have been fully considered but they are not persuasive. .

8) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


JOHN ULM
PRIMARY EXAMINER
GROUP 1800